No. 17-571

IN THE

Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,

Petitioners,

—v.—

WALL-STREET.COM, LLC, *et al.*,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF OF THE AMERICAN BAR ASSOCIATION AS *AMICUS CURIAE* SUPPORTING PETITIONER

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QUESTION PRESENTED

Whether "registration of [a] copyright claim has been made" within the meaning of § 411(a) when the copyright holder delivers the required application, deposit, and fee to the Copyright Office, as the Fifth and Ninth Circuits have held, or only once the Copyright Office acts on that application, as the Tenth and, in the decision below, the Eleventh Circuit have held.

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INTEREST OF AMICUS CURIAE[1]

The American Bar Association ("ABA") respectfully submits this brief as amicus curiae in support of Petitioner Fourth Estate Public Benefit Corporation ("Fourth Estate").

The ABA is the leading national organization of the legal profession, with more than 400,000 members from all 50 states, the District of Columbia, and the U.S. territories. Membership is voluntary and includes attorneys in private practice, government service, corporate law departments, and public interest organizations. ABA members include judges, legislators, law professors, law students, and non-lawyer "associates" in related fields, and represent the full spectrum of public and private litigants.[2]

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[1] Pursuant to Supreme Court Rule 37.6, *amicus curiae* certifies that no counsel for a party authored this brief in whole or in part and that no person or entity, other than *amicus curiae* or its counsel, has made a monetary contribution to its preparation or submission. The parties have granted blanket consent for the filing of *amicus curiae* briefs.

[2] Neither this brief nor the decision to file it should be interpreted to reflect the views of any judicial member of the American Bar Association. No inference should be drawn that any member of the Judicial Division Council has participated in the adoption or endorsement of the positions in this brief. This brief was not circulated to any member of the Judicial Division Council prior to filing.

The ABA Section of Intellectual Property Law ("IPL Section"), which was established in 1894 (three years before the Copyright Office was created), is the world's oldest and largest organization of intellectual property professionals. The IPL Section has approximately 20,000 members, including attorneys who represent authors, copyright owners, accused infringers, a wide range of companies across the entertainment and technology industries, and public interest organizations and institutions such as libraries, archives, and museums.

The IPL Section promotes the development and improvement of intellectual property law and takes an active role in addressing proposed legislation, administrative rule changes, and international initiatives regarding intellectual property. It also develops and presents resolutions to the ABA House of Delegates for adoption as ABA policy to foster necessary changes to the law. These policies provide a basis for the preparation of ABA amicus curiae briefs, which are filed primarily in this Court and the United States Court of Appeals for the Federal Circuit.[3] The IPL Section includes and represents attorneys on all sides of issues of intellectual property law, and its reliance on the expertise of its members to develop consensus positions within the ABA

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[3] *See* ABA, Amicus Curiae Briefs, http://www.americanbar.org/amicus/1998-present.html (last visited August 29, 2018).

ensures its positions reflect those of the broader intellectual property community.

SUMMARY OF ARGUMENT

The ABA is concerned about the adverse impact on attorneys, their clients, and the judicial system of requiring copyright holders to wait to seek relief for copyright infringement until a certificate of registration is issued by the Copyright Office or the Copyright Office refuses to issue one. This "**certificate approach**" to the term "registration" in the Registration and Civil Infringement Actions provision of the Copyright Act, 17 U.S.C. § 411(a) denies access to the courts in a manner inconsistent with the overall structure and nature of the Copyright Act.[4] By contrast, the "**application approach**"—which merely requires a copyright holder to submit a complete set of registration materials (*i.e.*, an application, deposit copy, and registration fee) to the Copyright Office—is more consistent with the text of Subsection 411(a), the text of neighboring Copyright Act provisions, the purposes of the Copyright Act, and the overall copyright system.

The ABA closely has monitored—long before the *Fourth Estate* case itself—the circuit split between the

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[4] While Respondents and certain lower court opinions refer to this as the "registration" approach, that name is misleading because, as discussed below, the term "registration" in the Copyright Act properly means the act of delivering a copyright application, deposit copy, and fee to the Copyright Office.

"certificate approach" and the "application approach." After careful analysis and input from its members, many of whom are expert intellectual property practitioners, the ABA IPL Section adopted a resolution favoring the application approach in October 2017. The ABA House of Delegates adopted a similar resolution on behalf of the ABA as a whole in February 2018. The ABA favors the application approach interpretation of Subsection 411(a) for several reasons.

First, the application approach better reflects the text of the Copyright Act. As an initial matter, this Court already has considered the text of Subsection 411(a) in *Reed Elsevier, Inc. v. Muchnick* and tacitly recognized that the term "registration" in that Subsection refers to an act performed by copyright holders (when they submit their applications, deposits, and fees to the Copyright Office) not the Copyright Office (when it issues or refuses to issue a certificate of registration). *See* 559 U.S. 154, 158 n.1 (2010) (considering "the registration process" and the "incentives to encourage *copyright holders* to register their works" (emphasis added)). Similarly, other provisions of the Copyright Act describe "registration" as something that the copyright holder "may obtain" when she delivers the registration materials to the Copyright Office without reference to the Office's issuance or refusal of a certificate memorializing that registration. *See infra* 9. Moreover, the "effective date of registration" is the date on which the copyright holder delivers her registration materials to the

Copyright Office, *not* when the Copyright Office issues its decision. *See infra* 9.

Second, the application approach is particularly important to copyright practitioners who submit copyright registrations and counsel clients on the meaning of the Copyright Office's review. In sharp contrast to patent law—where no rights exist until and unless a patent is formally issued—under copyright law, a copyright exists at the moment an original work is "fixed" in a "tangible medium of expression," regardless of any action by the Copyright Office. *See infra* 13. In addition, unlike in patent law, the Copyright Office's refusal to issue a certificate of registration for a work has no preclusive effect on the district court, which reviews copyrightability *de novo*.[5] *See infra* 21. As copyrights exist regardless of whether works are registered, and the Copyright Office's position on copyrightability is not binding on the courts, it does not make sense and would be an abrupt departure for copyright practitioners from the normal operation of copyright law to interpret Subsection 411(a) as requiring receipt of a final

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[5] To be clear, the ABA has great respect for the Copyright Office and the role that it plays in the copyright system. But the submission of registration materials to the Copyright Office should suffice for a copyright holder to gain access to the courts. Under this approach, a court still benefits from the Copyright Office's views at some point early in the case, and the benefits of collecting deposit copies and filing fee revenues are still realized, but in a manner that better enables litigants to obtain adequate redress.

decision from the Copyright Office before a lawsuit can be commenced.

Third, the application approach avoids the draconian impact that the certificate approach has on litigants as it permits the prompt filing of lawsuits to obtain urgent injunctive relief, while still ensuring that copyright holders register their works with the Copyright Office. *See infra* 23. It also eliminates the adverse consequences for meeting the Copyright Act's short three-year statute of limitations that can flow from the certificate approach's preclusion of suit until the Copyright Office decides whether to issue a certificate of registration. *See infra* 29.

Finally, the application approach reduces the inequity authors of United States works face as Subsection 411(a)'s prerequisite applies only to them, not authors of foreign works, who are entirely exempt from Subsection 411(a)'s registration requirement to gain access to United States courts. By permitting copyright holders to bring suit as soon as their registration materials are filed, rather than when the Copyright Office eventually decides whether to issue a certificate of registration, the application approach minimizes the additional burden on authors of United States works in gaining access to the court system. *See infra* 33.

For these reasons, and as further detailed below, the application approach to Subsection 411(a) better comports with the Copyright Act as a whole, and

better serves authors of United States works, their lawyers, and the judicial system at large.

ARGUMENT

I. THE APPLICATION APPROACH IS CONSISTENT WITH THE TEXT OF THE COPYRIGHT ACT

Subsection 411(a) of the United States Copyright Act states that, subject to certain exceptions, "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). The issue before this Court is the meaning of the term "registration" in this Subsection.

When confronted with a question of statutory interpretation such as this, this Court "begin[s] by examining the text," *Carter v. United States*, 530 U.S. 255, 271 (2000), including both "the particular statutory language at issue, as well as the language and design of the statute as a whole," *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281, 291 (1988). The Copyright Act defines the term "registration" to mean "a registration of a claim in the original or the renewed and extended term of copyright." 17 U.S.C. § 101. This self-referential definition sheds little light on the meaning of Subsection 411(a) because it does not indicate what steps must be taken, and by whom, for registration to occur.

In contrast to its unhelpful definition of the term "registration," the Copyright Act makes clear through other provisions that submitting a copyright application, deposit copy, and fee is sufficient to satisfy the requirements of Subsection 411(a). This Court already implicitly has read the text of Subsection 411(a) as providing that registration occurs when the copyright holder acts by delivering her application, deposit copy, and fee to the Copyright Office. In *Reed Elsevier, Inc. v. Muchnick*, this Court found that Subsection 411(a)'s registration requirement was a precondition to filing rather than a limitation on a court's subject-matter jurisdictional prerequisite. 559 U.S. 154. In so holding, this Court highlighted the "incentives to encourage *copyright holders* to register their works." *Id.* at 158 n.1 (emphasis added). [6]

Neighboring provisions to Subsection 411(a) also confirm that registration is dependent upon the

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[6] Relatedly, reading Subsection 411(a) to give the Copyright Office control over which authors can enforce their copyrights and when is inconsistent with the fundamental rule expressed in the Copyright Act that copyright "subsists . . . in original works of authorship fixed in a tangible medium of expression," 17 U.S.C. § 102(a), and that fixation occurs when the work is made sufficiently permanent "by or under the authority of the author," *id.* § 101. This language makes clear that copyright protection is contingent upon the author's acts, not Copyright Office action. Reading Subsection 411(a) to increase arbitrarily the burden on authors to enforce their copyrights is inconsistent with this "broader context of the [Copyright Act] as a whole." *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997).

copyright holder's conduct, not that of the Copyright Office. Possibly most critically, Subsection 410(d) expressly states that the effective date of a registration is the "day on which an application, deposit, and fee" are submitted to the Copyright Office. *Id.* § 410(d); *see also Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 617 (9th Cir. 2010). Thus, registration is deemed to have occurred when the copyright holder submitted the registration materials, *not* when the Copyright Office issued a certificate memorializing that registration. It would be inconsistent with the statute's text to interpret Subsection 411(a) as saying that registration does not occur until the Copyright Office acts, because that would suggest that the date of the Copyright Office's action is the date of registration, which the plain language of Subsection 410(d) refutes. The application approach accords with this language by focusing on the timing of the submission of registration materials.

In addition, Subsection 408(a) expressly states that "[t]he owner of copyright or of any exclusive right in the work *may obtain registration . . . by delivering* to the Copyright Office the deposit specified by this section, together with the application and fee specified." 17 U.S.C. § 408 (emphasis added). This confirms that the copyright holder alone effectuates registration by "delivering" registration materials. The certificate approach would have the Court read into the statute the additional words "and receiving a certificate of registration or refusal from the

Copyright Office," but that is not what the plain text says.[7]

Similarly, the latter part of Subsection 411(a) shows that registration does not require Copyright

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[7] Respondents argue that Section 408's preregistration provision supports the certificate approach, *see* Respondents' Brief in Opposition to Petitioner's Petition for Certiorari ("Resp. Cert. Br.") 15, but Section 408 is a red herring. As an initial matter, preregistration is a completely distinct process from the registration process that is at issue in this appeal, applying in a unique set of circumstances involving delineated types of works. Moreover, the text of Section 408 does not support Respondents' assertion that submitting an application, deposit copy, and fee under Subsection 408(f)(3) constitutes an "application for registration," rather than a registration. The statute makes clear that the phrase "application for registration" refers to solely the application *form*, not the combined registration materials. *See* 17 U.S.C. § 408(f)(3)(A) ("application for registration" is one out of three materials that must be submitted); *id.* § 409 (describing an "application for copyright registration" without mention of deposit copies or fees). Respondents also argue that Subsection 408(f) states that a preregistrant "must 'appl[y] for registration of the work'" by submitting an application, deposit copy, and fee. Resp. Cert. Br. 15 (quoting 17 U.S.C. § 408(f)(3)). The text, however, does not provide that submitting these materials constitutes "application." Instead, it merely says that one must "submit to the Copyright Office" the enumerated materials. 17 U.S.C. § 408(f)(3). Lastly, the Government's argument that the application approach would render the preregistration scheme unnecessary, *see* U.S. Amicus Br. 16–17, does not stand as, under either approach, an author wanting to sue for infringement of an unfinished, unpublished work would be unable to do so without the benefit of preregistration.

Office action. That provision permits the copyright holder to file suit even "where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and *registration has been refused*." 17 U.S.C. § 411(a) (emphasis added). The language here is telling because saying "registration has been refused" in the past tense contemplates a registration upon filing, which only later was refused. Indeed, this phrasing suggests that the act of registration is something *distinct* from the act of refusal. If these acts were one and the same, this provision would not make sense, as the Copyright Office cannot refuse to accept a registration that does not yet exist.[8]

Finally, while advocates of the certificate approach argue that the Copyright Office must act for registration to occur, the provisions on which they rely actually support the application approach because each of those provisions focuses on issuance of the "certificate of registration." *Id.* §§ 408(a), 410(a). This

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[8] In interpreting this portion of Subsection 411(a), some certificate-approach courts have found that because the provision contemplates that one may submit the "deposit, application, and fee required for registration" yet registration may still be refused, the submission of registration materials cannot constitute registration, *see La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200–01 (10th Cir. 2005); *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1341 (11th Cir. 2017). But again, the plain text undermines this argument, as it construes registration and acceptance or refusal of the registration as different things.

makes sense under the application approach as the act of registration (filing the application, deposit copy, and fee with the Copyright Office) is different from the issuance of a certificate of registration. By contrast, the certificate approach would require treating two different terms used by Congress—"registration" and "certificate of registration"—as defining the same conduct. This is contrary to the standard rules of statutory interpretation. *See Jama v. Immigration & Customs Enforcement*, 543 U.S. 335, 358 (2005) (explaining that a statute should be interpreted so that "distinct words have distinct meanings").[9]

As a result, "only one of the permissible meanings produces a substantive effect that is compatible with the rest of the law." *United Sav. Ass'n of Tex. v. Timbers of Inwood Forest Assocs., Ltd.*, 484 U.S. 365, 371 (1988). Submitting an application, deposit copy, and fee to the Copyright Office constitutes "registration" under Subsection 411(a).

II. THE APPLICATION APPROACH BETTER REFLECTS THE UNIQUE NATURE AND PURPOSE OF COPYRIGHT LAW AS OPPOSED TO PATENT LAW

As discussed above, the application approach is the better reading of the Copyright Act. At best, those supporting the certificate approach have raised arguments suggesting that the term "registration" is

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[9] *See also* 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][3][a][i] (2013) (hereinafter NIMMER).

ambiguous. When this Court is confronted with an ambiguous statute, it looks to the "statutory context, 'structure, history, and purpose.'" *Abramski v. United States*, 134 S. Ct. 2259, 2267 (2014) (quoting *Maracich v. Spears*, 570 U.S. 48, 76 (2013)).

There can be no debate that the application approach is more consistent with the purpose of the statute and the unique role of the Copyright Office. As discussed below, adopting this approach is critical to the ABA as copyright practitioners prosecute copyright registrations and advise their clients on copyright law issues every day. The certificate approach diverges from ordinary copyright principles in an unhelpful and inconsistent manner.

A. Copyright is Created through Fixation in a Tangible Medium, Not Copyright Office Grant

While this Court sometimes has analyzed copyright and patent as analogous regimes due to their "historic kinship," *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439 (1984), there are fundamental differences in the way individuals and their lawyers secure rights under these regimes that have critical bearing on the question presented.

Under patent law, no patent rights exist until the Patent and Trademark Office ("PTO") undertakes an extensive analysis of factors including novelty, obviousness, and subject matter, and formally issues

a patent. In other words, one can acquire patent rights through *only* an express grant from the PTO after the intense application process detailed below; "the patentee has no exclusive right of property in his invention, except under and by virtue of the statutes securing it to him, and according to the regulations and restrictions of those statutes." *Dable Grain-Shovel Co. v. Flint*, 137 U.S. 41, 43 (1890); *see also Morrow v. Microsoft Corp.*, 499 F.3d 1332, 1336–37 (Fed. Cir. 2007).

By contrast, Congress designed the Copyright Act to allow copyright to "subsist" from the time that an author fixes a work in a "tangible medium of expression," with no Copyright Office input required. 17 U.S.C. § 102(a). The Copyright Office is not positioned as a gatekeeper for deciding who receives copyrights and when those rights arise. Thus, unlike the PTO, "[t]he Copyright Office does not grant copyrights." *Chere Amie, Inc. v. Windstar Apparel, Corp.*, 191 F. Supp. 2d 343, 350 (S.D.N.Y. 2011).

This is not to say that registration with the Copyright Office is not, or should not be, encouraged.[10] ABA practitioners regularly counsel their clients to register their copyrighted works, as it confers many practical benefits. For example, a certificate of registration can constitute *prima facie* evidence of a

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[10] *See* H.R. REP. NO. 94-1476, at 158 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5774 (stating that a robust register of copyrighted works "is useful and important to users and the public at large").

copyright's validity, *see* 17 U.S.C. § 410(c), and timely obtaining a certificate may enable the copyright holder to seek statutory damages and attorney's fees for infringement, *see id.* §§ 411, 412, 501–505. But while a certificate of registration might afford the copyright holder litigation benefits, it does *not* determine whether, and when, copyright exists.

Critically, the certificate approach does not incentivize registration of copyrighted works any more than the application approach. Under *either* approach, copyright holders must register their copyrights to enforce them against infringers.[11] Congress's express aim in the Copyright Act was to induce copyright registration "in some *practical* way."[12] ABA practitioners have found that the application approach—which furthers the goals of the registration system to the same extent as the certificate approach—achieves this in the manner that "best effectuate[s] the interests of justice and promote[s] judicial economy." *Int'l Kitchen Exhaust Cleaning Ass'n v. Power Washers of N. Am.*, 81 F. Supp. 2d 70, 72 (D.D.C. 2000).

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[11] *See* Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ARTS 311, 340–41 (2010) ("Where the author has in fact sought to make the requisite public record of her claim, it is unclear what public policy such a wooden approach . . . to registration advances.").

[12] H.R. REP. NO. 94-1476, at 158 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5774 (emphasis added).

Thus, the application approach better accords with the structure of the Copyright Act.

B. The Procedural Barriers to Patent Protection are Higher than Copyright

The application approach also better accords the Copyright Office's review procedure, which in turn reflects the basic tenet of copyright that legal rights arise upon the author's fixation in a tangible medium, which typically occurs before the Copyright Office is called upon for review. In contrast to the patent regime, Congress did not position the Copyright Office as a gate-keeper to copyright protection so much as a steward looking after authors and their works. The application approach better reflects the important practical distinctions between these systems.

Specifically, patent practitioners regularly find that patent law imposes demanding subject-matter, novelty, and non-obviousness requirements on inventors seeking patent protection. *See Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 824 (11th Cir. 1982) (noting that "courts generally agree that 'originality' for copyright purposes is something less than the novelty or uniqueness necessary for patent protection"). Consistent with the fact that the PTO's decision on patentability determines whether an inventor receives patent rights, the review required prior to

issuance of a patent is extremely demanding.[13] *See, e.g.*, *Prima Tek II, L.L.C. v. Polypap, S.A.R.L.* 412 F.3d 1284, 1287 (Fed. Cir. 2005) (noting that the patent application process is so demanding because the "patent system depends primarily on the Patent and Trademark Office's . . . care in screening out invalid patents during prosecution"). In addition to the statutory requirements for patentability, the patent itself must satisfy an additional set of requirements. In particular, it must (1) provide a written description showing actual possession of the invention; and (2) enable a person of ordinary skill in

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[13] To obtain a utility patent, an applicant must prove to the PTO that a claimed invention is a "new and useful process, machine, manufacture, or composition of matter," 35 U.S.C. § 101, that is novel and nonobvious, *id.* §§ 102, 103. The inventor must prove this in a written application consisting of a specification, drawing, and oath or declaration. *See id.* § 111. Once submitted, the application is assigned to a patent examiner who begins a rigorous process of review. This involves a "thorough study" of prior art (*i.e.*, things that have already been invented) to test for novelty and nonobviousness. 37 C.F.R. § 1.104(a). The examiner looks "both to compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form." *Id.* The patent examination process is an "ongoing negotiation," *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc), that usually involves initial rejection, narrowing or clarification efforts from the applicant, reconsideration by the examiner, evidentiary submissions, amendments, and other steps depending upon the claims at issue, *see, e.g.*, *In re Brandt*, 886 F.3d 1171, 1175–76 (Fed. Cir. 2018).

that art or field to make and use the invention without undue experimentation. 35 U.S.C. § 112(a)–(b). Although litigants often challenge the patentability of the subject invention in patent litigation, it is also common to challenge these elements of the patent itself.

Unlike the rigorous, highly formal requirements of obtaining patent rights, this Court has made clear that copyright has a low threshold that permits any work that has been "independently created by the author" and that possesses "at least some minimal degree of creativity" to qualify for protection. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). Thus, while the Copyright Office reviews an application to make sure that it comports with the overall requirements of copyrightability, it is not the same type of analysis typically conducted by the PTO. The application approach better accords with this reality.

In fact, the United States systematically has sought to *remove* administrative barriers to copyright protection (known as formalities). *See, e.g.*, Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853. As a result, submitting works to the Copyright Office "is not a condition of copyright protection." 17 U.S.C. § 408(a). Nor is compliance with other formalities—such as affixing copyright notices to the work—required. *See id.* § 401 (stating that a notice of copyright "*may* be placed" on copies of the work (emphasis added)); *id.* § 407(a) ("Neither the deposit requirements of this subsection

nor the acquisition provisions of subsection (e) are conditions of copyright protection."). The net-effect of these critical legislative decisions is that a work is protected by copyright law as soon as the author creates it in tangible form, regardless of the Copyright Office's subsequent opinion on whether the work deserves a certificate of registration.

Consistent with the foregoing, the Copyright Office's policy is to conduct only a high-level review of submitted registration materials,[14] focusing on whether "the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of [the Copyright Act] have been met." *Id.* § 410. Although the Copyright Office reviews some substantive qualities of the work, a certificate of registration "is usually granted as a matter of course, so long as the applicant correctly files their application and the deposited subject matter is within the scope of copyright protection."[15]

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[14] Indeed, Congress understood that, "unlike a patent claim, a claim to copyright is not examined for basic validity before a certificate is issued." H.R. Rep. 94-1476, at 5773.

[15] Ben Depoorter & Robert Kirk Walker, *Copyright False Positives*, 89 NOTRE DAME L. REV. 319, 348–49 (2013). The Copyright Office admits that in its review, it "generally does not compare deposit copies to determine whether the work for which registration is sought is substantially similar to another work." *See, e.g.*, U.S. COPYRIGHT OFFICE, COMPENDIUM 602.4(C). Nor does it undertake a substantive review of prior registrations to ascertain what, if any, expression in the application is protected. *See, e.g.*, Ginsburg, *supra* note 11, at 347 (noting that the "bulk" of

If the Copyright Office has questions about matters in an application, it will informally correspond with the copyright holder, often seeking additional materials or written answers to clarify and remedy any perceived issues. Once its examination is complete, the Copyright Office either will issue a certificate of registration, effective as of the date it received the registration materials, *see id.* § 410(d), or will refuse to issue a certificate, notifying the copyright holder in writing of the reasons for refusal, *see id.* § 410(a)–(b).

Finally, it should not go unnoticed that while patent litigants routinely challenge both the validity of the patented invention and the sufficiency of the patent specification itself, in copyright cases, the words of the certificate are almost never relevant and even copyrightability is rarely challenged due to the low standard described above. This further supports why the certificate approach is ill-suited to the needs of litigation: it places weight on Copyright Office formalities that are generally irrelevant to the

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examination time is spent reviewing information in the application form, not "ascertaining originality"). Indeed, "[t]he enforcement of the substantive provisions of Copyright law by the Copyright Office is . . . limited." Arthur J. Levine & Jeffrey L. Squires, *Notice, Deposit and Registration: The Importance of Being Formal*, 24 UCLA L. REV. 1232, 1262 (1977). As a result, and as the United States government has admitted, the Copyright Office accepts approximately *ninety-nine* percent of the applications it receives. *See* U.S. Br. at 4 n.2, *Reed Elsevier v. Muchnick*, 559 U.S. 154 (2010).

protectability of a work or the merits of copyright infringement suits.

C. The Copyright Office's Opinion on Registrability is Not Binding on Courts

In addition to the certificate of registration being an infrequent focus of copyright litigation, even where the Copyright Office refuses to issue such a certificate, copyright litigation still may commence. *See* 17 U.S.C. § 411(a). This makes sense given that the Copyright Office's views with respect to copyrightability do not dictate the existence, scope, or validity of copyrights.

In fact, even when courts have access to the Copyright Office's decision in a copyright infringement litigation, "copyrightability is a question of law reserved to the judge and subject to *de novo* review by appellate courts." *Darden v. Peters*, 402 F. Supp. 2d 638, 641 (E.D.N.C. 2005), *aff'd*, 488 F.3d 277 (4th Cir. 2007); *see also Bartok v. Boosey & Hawkes, Inc.*, 523 F.2d 941, 946 (2d Cir. 1975) (noting that the "Copyright Office has no authority to give opinions or define legal terms"). Indeed, it is well-settled that Copyright Office decisions on copyrightability are entitled to the lower level of deference afforded under *Skidmore v. Swift & Co.*, 323 U.S. 134 (1994). *See, e.g., EMI Christian Music Grp., Inc. v. MP3tunes, LLC*, 844 F.3d 79, 97 (2d Cir. 2016); *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 479 (6th Cir. 2015), *aff'd sub nom. Star Athletica, L.L.C. v. Varsity*

Brands, Inc., 137 S. Ct. 1002 (2017). Accordingly, a federal court may elect to follow Copyright Office opinions where it finds them "persuasive and reasonable," *Fox Television Stations, Inc. v. Aereokiller, LLC*, 851 F.3d 1002, 1013 (9th Cir. 2017), but ultimately, where a copyright owner is denied certificate of registration prior to bringing an infringement action, courts "make an independent determination as to copyrightability," *Aqua Creations USA Inc. v. Hilton Hotels Corp.*, No. 10 Civ. 246, 2011 WL 1239793, at *3 (S.D.N.Y. Mar. 28, 2011), *aff'd sub nom. Aqua Creations USA Inc. v. Hilton Worldwide, Inc.*, 487 Fed. App'x 627 (2d Cir. 2012).[16]

Given that the Copyright Office's decision on copyrightability is not binding, the application approach better reflects that the Copyright Office's opinion likely will have little bearing on substantive issues before a court.[17]

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[16] *See also* NIMMER, *supra* note 9, § 12.11[B][3].

[17] *See, e.g.*, *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985) (mannequin figures listed as "sculptures" in certificates of registration not copyrightable); *Sari v. America's Home Place, Inc.*, 129 F. Supp. 3d 317, 326–28 (E.D. Va. 2015) (architectural plans not copyrightable even though Copyright Office issued certificate of registration); *I.C. ex rel. Solovsky v. Delta Galil USA*, 135 F. Supp. 3d 196, 213–15 (S.D.N.Y. 2015) (t-shirt design sufficiently original to make out *prima facie* case of copyright validity despite Copyright Office's refusal to issue registration certificate); *ATCS Int'l LLC v. Jefferson Contr. Corp.*, 807 F. Supp. 2d 516, 518 (E.D. Va. 2011) (drawings were nonprotectable "functionally driven designs" even

III. THE APPLICATION APPROACH SAFEGUARDS AUTHORS' ABILITIES TO EFFECTIVELY RESOLVE INFRINGEMENT CLAIMS

The application approach resolves numerous critical issues of timing, efficiency, and access to effective redress that arise under the certificate approach.

A. The Application Approach Ensures that Authors May Seek the Injunctive Relief that is Critical to Copyright Litigation

Significantly, the application approach ensures that copyright holders may go to court to obtain injunctions or temporary restraining orders "to prevent or restrain infringement of a copyright" as early as possible. 17 U.S.C. § 502. One of the unique characteristics of copyright law is the frequent need for copyright holders to seek emergency injunctive relief. As ABA members are well aware, monetary relief often does not suffice to remedy copyright infringement and injunctive relief is the only way of

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though plaintiff held certificate of registration); *Sapon v. D.C. Comics*, No. 00 Civ. 8992, 2002 WL 485730, at *7 (S.D.N.Y. Mar. 29, 2002) (plaintiff's "Black Bat" drawings not sufficiently original despite fact that Copyright Office issued certificate of registration); *Past Pluto Prods. Corp. v. Dana*, 627 F. Supp. 1435, 1440–42 (S.D.N.Y. 1986) (design for foam hat of Statue of Liberty Crown not protectable despite Copyright Office issuing certificate of registration).

preventing irreparable injury. *See, e.g.*, *Salinger v. Colting*, 607 F.3d 68, 81 (2d Cir. 2010) (injunction warranted because harm to plaintiff is often "irreparable in light of possible market confusion"); *Omega Imp. Corp. v. Petri-Kine Camera Co.*, 451 F.2d 1190, 1195 (2d Cir. 1971) (noting that "prov[ing] the loss of sales due to infringement is . . . notoriously difficult"). Moreover, circumstances often arise in practice where several days of delay in filing for an injunction can make a world of difference, such as where an infringing work will undermine the demand for the yet-to-be-released original, *see New Line Cinema Corp. v. Bertlesman Music Grp., Inc.*, 693 F. Supp. 1517, 1530–31 (S.D.N.Y. 1988), or the market for the original work is "fleeting" in nature and will be displaced by the infringer, *see Lakedreams v. Taylor*, 932 F.2d 1103, 1109 (5th Cir. 2011). Indeed, "it is virtually axiomatic that the public interest can be served only by upholding copyright protections and, correspondingly, preventing the misappropriation of the skills, creative energies, and resources which are invested in the protected work." *Apple Comput., Inc. v. Franklin Comput. Corp.*, 714 F.2d 1240, 1254–55 (3d Cir. 1983).

As a copyright holder need not register a work to hold a copyright in it, it is common practice for authors not to immediately register their works, particularly given the rapid manner in which works are created in the modern world and the expense of keeping up with such registrations. Thus, it is foreseeable under the certificate approach that a copyright holder could learn of incipient infringement,

but be unable to sue immediately to obtain injunctive relief because she does not yet have a certificate of registration or refusal in hand. By the time the copyright holder's certificate of registration is either issued or refused, irreparable damage already may have occurred, and the proverbial horse will have left the barn.

While requiring a copyright holder to obtain a decision from the Copyright Office prior to filing suit may sound like a trivial delay, these delays present real problems. As of July 2018, the Copyright Office reports that a certificate of registration may issue anywhere between *three and twenty-eight months* after a copyright holder submits her application, deposit copy, and fee.[18] The length of time depends upon factors such as the form in which the application was submitted (*i.e.*, online or via mail), "how difficult a claim is to review, whether the Copyright Office needs to correspond with an applicant, and the number of registration specialists available to review claims."[19]

On average, the delay between filing and decision for online claims with no ensuing correspondence is seven months, and nine months for those requiring

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[18] *See* U.S. Copyright Office, Registration Processing Times, https://copyright.gov/registration/docs/processing-times-faqs.pdf (last visited August 29, 2018).

[19] *Id.*

correspondence.[20] For claims made through the mail, the Copyright Office's review takes an average of nine months if there is no correspondence, and sixteen months with correspondence.[21] Thus, if a copyright holder learns of infringement early enough to stop it, but must wait to bring an infringement action until the Copyright Office issues either a certificate of registration or a refusal, the copyright holder effectively could lose her ability to get the immediate temporary restraining order or preliminary injunctive relief needed to best protect her interests.

The United States Government's brief asserts that this concern can be remedied by authors filing their registration materials through the Copyright Office's expedited review process known as "special handling." Brief for the United States as Amicus Curiae ("U.S. Amicus Br.") 22.[22] But special handling is not a solution. As a threshold matter, special handling is available only in limited circumstances, namely "pending or prospective litigation," "customs matters," and "contract or publishing deadlines that necessitate the expedited issuance of a certificate."[23] In addition, even accepting at face value the Copyright Office's

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[20] *See id.*

[21] *See id.*

[22] U.S. COPYRIGHT OFFICE, COMPENDIUM 207 (2017).

[23] *Id.* at 623.2 (explaining prerequisites, process, and requirements for special handling).

goal to resolve expedited requests within five working days, this delay could still be the difference between an infringing work being publicly disseminated all over the world or not.[24] Moreover, the ABA's members report it can take much longer than five days for the Copyright Office to issue a decision through special handling. Indeed, ABA practitioners find it can take three or more weeks for the expedited decision to issue, if not longer.

Even if a copyright holder qualifies for special handling, in reality, this period of inaction can allow the infringement to spread far beyond the initial infringer and become impossible to track down and rectify. *See A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001). As the Ninth Circuit has recognized, "the application approach avoids unnecessary delays in copyright infringement litigation, which could permit an infringing party to continue to profit from its wrongful acts," without "impairing the central goal of copyright registration." *Cosmetic Ideas*, 606 F.3d at 619–20.[25] Importantly, it also eliminates the need for victims of copyright infringement to incur the often prohibitive additional

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[24] *See id.* at 623.4.

[25] *See also* Shira Perlmutter, *Freeing Copyright from Formalities*, 13 CARDOZO ARTS & ENT. L.J. 565, 582 (1995) ("If the automatic attachment of rights may be reversed in whole or in part by inadvertent forfeitures of rights or remedies, the structure of incentives is seriously undercut.").

expense required to expedite Copyright Office review of an application.

Moreover, it should not be overlooked that special handling requires an *$855 fee*, as opposed to the $55 required for standard registration.[26] For many copyright holders, such as individual artists, photographers, and start-ups, this expense simply is not feasible. Moreover, this $855 sum could be compounded many times over if a copyright holder wants to sue on multiple works at the same time, or must continually file copyright applications due to the repeated infringement of her rights. Although copyright holders with limited resources have some hope of recovering their attorney's fees and costs incurred pursuing their claims should they ultimately prevail, *see* 17 U.S.C. § 504, they have no hope of recovering this steep special handling fee.[27] The net

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[26] *See* U.S. Copyright Office, Fees, https://copyright.gov/about/fees.html (last visited August 29, 2018).

[27] Significantly, statutory damages and attorney's fees only would be available if the registration is made prior to the infringement, which is unlikely under the above circumstances, or within three months of publication. *See* 17 U.S.C. § 412; *see also* Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439, 545–55 (2009) (noting that "'[l]ittle guy' authors . . . in theory, have the same strong legal rights as major copyright industry players, but . . . effectively do not have the means to obtain relief when their rights are infringed" under the statutory damages limitations).

result is that authors who cannot afford the special handling fees may be deprived of the ability to obtain recourse for infringement of their rights. These burdens are inconsistent with copyright law's constitutional goal of incentivizing the creation and dissemination of new works by giving authors a limited monopoly for a period of time, as leaving authors effectively unable to protect their rights disrupts copyright's incentive system.

B. The Application Approach Better Accounts for Copyright Infringement's Short Statute of Limitations

The Copyright Office's delay in deciding whether to issue or refuse to issue a certificate of registration also has consequences for meeting the short three-year statute of limitations under the Copyright Act. The application approach reduces the likelihood that copyright claims will become statute of limitations barred in the time between filing an application, deposit copy, and fee with the Copyright Office and receiving a final decision.

Copyright infringement claims are subject to a short, three-year statute of limitations. *See* 17 U.S.C. § 507(b). Under the certificate approach, the statute of limitations may run out while the copyright holder waits for a decision from the Copyright Office, thus forever foreclosing a meritorious claim. By contrast, the application approach avoids this abject unfairness by allowing copyright holders to file suit within the

statute of limitations while Copyright Office review is ongoing.

This issue is even more significant in courts that calculate the limitations period from the time infringement begins (*i.e.*, using the "injury rule"), rather than the time the author discovers it (*i.e.*, the "discovery rule"). *See Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 n.4 (2014) (noting that not all circuits have adopted the discovery rule for infringement claims). In such circumstances, time is truly of the essence, as an author must find and craft claims against the infringer, and potentially also seek and obtain the Copyright Office's decision on whether to issue a certificate of registration, all within the three-year limitations period. Without justification, the certificate approach maximizes the hardship these authors must endure and might forever foreclose a copyright holder from bringing suit.

This statute of limitations issue is not idle conjecture. In *Kregos v. Associated Press*, the plaintiff filed his application with the Copyright Office in 1985, but due to an administrative delay, the Office did not issue a decision on that application until late 1988. 795 F. Supp. 1325, 1328 (S.D.N.Y. 1992). The district court held that the statute of limitations would not be tolled and barred plaintiff's copyright claim that fell outside of the three-year limitations period. *Id.* at

1331.[28] Copyright holders should not lose their property rights due to agency delay.

C. The Application Approach Eliminates the Wasteful Re-Filing of Infringement Claims that Occurs Under the Certificate Approach

The application approach also prevents the all-too-familiar circumstance of a court dismissing a copyright holder's infringement suit for failure to have a certificate of registration or refusal in hand, only to have the same claim refiled once the Copyright Office issues a decision later on. For example, in *Asche & Spencer Music, Inc. v. Principato-Young Entm't, Inc.*, 147 F. Supp. 3d 833, 838 (D. Minn. 2015), the court dismissed a copyright infringement claim after the copyright holder "obtained neither registration nor denial of registration from the Copyright Office" before filing suit, only for the plaintiff to file a new suit for infringement of the same works later, *see Asche & Spencer Music, Inc. v. Principato-Young Entm't, Inc.*, No. 17 Civ. 150 (D. Minn. filed Jan. 18, 2017); *see also*

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[28] *See also Cosmetic Ideas*, 606 F.3d at 620 (noting that "under the [certificate] approach, a plaintiff who applied for registration towards the end of the three-year period could see the statute of limitations expire during the time it took the Copyright Office to act on the application"); NIMMER, *supra* note 9, at § 7.16[B] [1][a][i] ("[G]iven . . . a three-year statute of limitations . . . the narrow [certificate] approach may indeed occasion complete inability to recover damages.").

Lumetrics, Inc. v. Blalock, 23 F. Supp. 3d 138 (W.D.N.Y. 2014) (dismissing copyright infringement complaint for failing to register all software allegedly infringed, only for plaintiff to refile listing registrations, *see Lumetrics, Inc. v. Blalock*, No. 6:14 Civ. 6322 (W.D.N.Y. filed June 11, 2014)); *Greene v. Columbia Records/ Sony Music Entm't*, No. 3 Civ. 4333, 2004 WL 3211771 (S.D.N.Y. Mar. 1, 2004) (copyright infringement complaint dismissed where plaintiff had not yet received a decision, only for plaintiff to file suit based on infringement of same musical composition later, *see Greene v. Columbia Records, Inc.*, No. 1:13 Civ. 6965 (S.D.N.Y. filed Sept. 30, 2013)). This is wasteful of both the parties' and the judiciary's resources and improperly places form over the substance of the claims, which is out of step with our overall judicial system.

The process of filing a complaint, opposing a motion to dismiss, and later refiling a claim is both taxing on litigants—particularly those with limited means—and district courts. Indeed, the cost of filing additional court papers to oppose dismissal, or an amended or second complaint, can be very costly and deny copyright holders access to justice. Moreover, it simply "makes little sense to create a period of 'legal limbo' in which suit is barred."[29] The application approach alleviates this problem.

Overall, the application approach minimizes the procedural barriers to obtaining adequate relief for

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[29] NIMMER, *supra* note 9, at § 7.16[B][3][b][ii].

copyright infringement, and enables copyright holders to seek such redress in a timely, efficient manner.

IV. THE APPLICATION APPROACH MINIMIZES PREJUDICE TO AUTHORS OF UNITED STATES WORKS

Significantly, the certificate approach further disadvantages authors of United States works in seeking relief in their own judicial system. In 1989, the United States became a signatory to the Berne Convention for the Protection of Literary and Artistic Works ("Berne")—an international treaty that, among other things, seeks to lessen formalities under copyright law, such as by eliminating the need to affix copyright notices and obtain registrations for works as conditions to copyright protection. Indeed, Berne mandates that, for foreign works, the "enjoyment and the exercise of . . . [copy]rights shall not be subject to any formality." Berne Convention art. 5(2), Sept. 9, 1886 (Paris Text 1971), S. Treaty Doc. No. 99–27 [hereinafter Berne Convention].

Yet, Berne permits its signatories to impose stricter requirements on authors within their own nation. Accordingly, United States law requires authors of United States works to comply with Subsection 411(a) before filing suit, while authors of foreign works seeking to sue in the United States face no such prerequisite. *See* 17 U.S.C. § 411(a) (applying only to "United States work[s]"); *id.* § 101 (defining "United States work"). This has resulted in a

situation where authors of foreign works have faster and cheaper access to United States courts than authors of United States works. *See* Berne Convention art. 5(3).

The application approach reduces the burden of this registration formality, and lessens discrimination against the owners of copyrights in United States works. If the certificate approach is followed, authors of United States works must submit registration materials to the Copyright Office, *and also* wait for the Register's decision before they can enforce their copyrights against infringers. As noted above, this can take months if not years. It is hard to see the logic in interpreting the term "registration" in a way that exacerbates the already significant impediment on the ability of authors of United States works to enforce their rights. Therefore, the ABA supports the application approach as a way of better protecting authors of United States works and facilitating the swift resolution of their copyright claims.

CONCLUSION

For the foregoing reasons, the ABA respectfully requests that the Court reverse the Eleventh Circuit's holding below.

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